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Attorneys for Plaintiff

11 Franco Whole Foods, LLC

12 **UNITED STATES DISTRICT COURT**

13 **FOR THE SOUTHERN DISTRICT OF CALIFORNIA**

14
15 Franco Whole Foods, LLC, a California limited
16 liability company,

17 Plaintiff,

18 v.

19 Fresca Mexican Foods, Inc., an Idaho
corporation,

20 Defendant.
21
22

Case No.: **'13CV0037 BTM WMC**

**COMPLAINT FOR DECLARATORY
RELIEF**

DEMAND FOR JURY TRIAL

23
24 Plaintiff, Franco Whole Foods, LLC ("Plaintiff") alleges as follows:

25 **NATURE OF ACTION**

26 1. On December 18, 2012, Plaintiff received from Defendant Fresca Mexican Foods,
27 Inc. ("Defendant"), the written cease and desist letter attached to this Complaint as Exhibit A (the
28 "Cease & Desist Letter"). In the Cease & Desist Letter, Defendant alleges that the Plaintiff has

infringed and is infringing its trademark rights in violation of state and federal law.

2. This lawsuit seeks a declaration from this Court, under 28 U.S.C. §§2201 and 2202, that Plaintiff has not and is not infringing Defendant's trademark rights under either state or federal law.

PARTIES

3. Plaintiff Franco Whole Foods, LLC is a limited liability company organized and existing under the laws of the State of California with its principal place of business located at 1225 Exposition Way, Suite 110, San Diego, California 92154.

4. Upon information and belief, Defendant Fresca Mexican Foods, Inc. is a corporation organized and existing under the laws of the State of Idaho with its principal place of business located at 11193 Emerald Street, Boise, Idaho 83713.

JURISDICTION AND VENUE

5. Jurisdiction with this Court is proper under 28 U.S.C. § 1331 (federal question jurisdiction) because this case involves an actual controversy arising under the Lanham Act, 15 U.S.C. § 11051, et seq.

6. This Court has personal jurisdiction over the Defendant because, upon information and belief, Defendant sells its food products to consumers or resellers located in this Judicial District. Upon information and belief, Defendant owns and operates the website <http://www.frescamex.com/>, from which distributors and wholesalers located within this Judicial District can inquire about reselling the Defendant's food products in this Judicial District. Nothing on the aforementioned website indicates that the Defendant does not transact business in this Judicial District. Finally, Defendant sent the Cease & Desist Letter to Plaintiff at an address located within this Judicial District. The aforementioned contacts with this Judicial District are sufficient to permit this Court to lawfully exercise personal jurisdiction over the Defendant.

7. Venue is proper in this District pursuant to 28 U.S.C. § 1391(b) because a substantial part of the events or omissions giving rise to this action occurred in this Judicial District.



PLAINTIFF'S TRADEMARK

8. Plaintiff specializes in the production and sale of high-quality flour and corn tortillas. Plaintiff's product line also includes precooked multigrain flatbreads.

9. On May, 23, 2012, Plaintiff filed a Trademark Application with the U.S. Patent and Trademark Office ("USPTO") to register the following trademark in Class 30 for "[t]ortillas":



(hereafter, the "TORTILLA FRESCA Design Mark"). The TORTILLA FRESCA Design Mark Application was assigned Serial No. 85/633,370.

10. Plaintiff's tortilla products bearing the TORTILLA FRESCA Design Mark are sold through retail distribution channels directly to individual consumers.

11. On September 19, 2012, the USPTO issued an Office Action in which the assigned Trademark Examining Attorney requested a disclaimer of the words "TORTILLA FRESCA" on the grounds that they were descriptive of the claimed goods. Also in the Office Action, the Trademark Examining Attorney stated that he had "searched the Office's database of registered and pending marks and [had] found no conflicting marks that would bar registration under Trademark Act Section 2(d)."

DEFENDANT'S CEASE & DESIST LETTER

12. In its Cease & Desist Letter, Defendant claims to own the following two Trademark Registrations:

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Reg. No. 1998933

FRESCA
MEXICAN FOODS

Mark:

Class 30: flour tortillas, corn tortillas and fried corn tortilla chips sold in bulk form to institutions and to wholesale markets

Reg. No. 21198264

Mark: FRESCA MEXICAN FOODS

Class 40: manufacturing of custom ordered food products for others

(hereafter "Defendant's Registrations").

13. In its Cease & Desist Letter, Defendant also claims to own exclusive rights to the word "FRESCA" in connection with tortillas and other prepared Mexican foods. However, on information and belief, Defendant does not own a U.S. trademark registration or application for the term "FRESCA" alone.

14. On information and belief, Defendant is a manufacturer of heat-pressed, hand-stretched flour and corn tortillas and tortilla chips.

15. On information and belief, Defendant sells its products in bulk to institutions and resellers and not to individual consumers.

16. Plaintiff believes that it is unlikely that consumers would confuse its tortilla products sold under its TORTILLA FRESCA Design Mark with Defendant's products sold under Defendant's Registrations or the term FRESCA, and therefore denies that its TORTILLA FRESCA Design Mark infringes Defendant's trademark rights under either state or federal law.

CAUSE OF ACTION

Declaratory Relief

17. Plaintiff re-alleges and incorporates by this reference Paragraphs 1 through 16, as though fully set forth herein.

18. Defendant has engaged in conduct that gives rise to a reasonable apprehension on the part of Plaintiff that it will face suit for trademark infringement under Section 32 of the Lanham Act, 15 U.S.C. § 1114(1) over its continuing advertising, promotion, and sale of tortillas bearing the TORTILLA FRESCA Design Mark.

19. Plaintiff's TORTILLA FRESCA Design Mark does not infringe Defendant's Registrations, or its use of the term FRESCA, for at least the following reasons: (a) the term

1 “fresca” is commonly understood by United States consumers of food products to mean “fresh”
2 and is therefore descriptive and not capable of identifying the source of food products; (b)
3 Defendant does not have substantially exclusive use of FRESCA in connection with food
4 products; (c) the design components of Plaintiff’s TORTILLA FRESCA Design Mark are
5 sufficiently distinctive and dissimilar to Defendant’s Registrations, or its use of the term
6 FRESCA, such that there is no likelihood of confusion; and (d) the parties’ respective customers
7 and marketing channels are sufficiently different such that it is unlikely that the consumers will
8 confront both marks together in the marketplace in a way that is likely to cause confusion as to
9 source.

10 20. Based on the Cease & Desist Letter, an actual controversy exists between Plaintiff
11 and Defendant concerning Plaintiff’s lawful advertising, promotion, and sale of tortillas bearing
12 the TORTILLA FRESCA Design Mark and Plaintiff’s application for registration of its
13 TORTILLA FRESCA Design Mark. A judicial declaration is necessary to settle this dispute and
14 to clarify the parties’ respective rights.

15 **PRAYER FOR RELIEF**

16 WHEREFORE, Plaintiff prays that:

17 A. the Court declare that Plaintiff’s advertising, promotion, and sale of tortillas
18 bearing the TORTILLA FRESCA Design Mark and its application to register its TORTILLA
19 FRESCA Design Mark, does not constitute trademark infringement or unfair competition under
20 state or federal law; and

21 21. the Court declare that Plaintiff’s continued advertising, promotion, and sale of
22 tortillas bearing the TORTILLA FRESCA Design Mark, and its application to register the
23 TORTILLA FRESCA Design Mark, has not caused irreparable harm or monetary damage to
24 Defendant; and

25 22. the Court declare that Plaintiff is entitled to use and register its TORTILLA
26 FRESCA Design Mark and that Defendant is not entitled to enjoin or prevent such use or
27 registration; and

28 23. the Court award Plaintiff its attorneys’ fees and costs incurred in this action; and

24. the Court award Plaintiff such other relief as the Court may deem just and proper.

Dated: January 8, 2013

Respectfully submitted,

IP Legal Advisors, P.C.

By:

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Pro Hac Vice Application Pending

Attorney for Plaintiff

Franco Whole Foods, LLC

DEMAND FOR JURY TRIAL

Pursuant to Federal Rule of Civil Procedure 38(b), Plaintiff demands a trial by jury.

Dated: January 8, 2013

Respectfully submitted,

IP Legal Advisors, P.C.

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